

**REMARKS**

- Claims 1 – 66 are currently pending in the present application.
- Upon the entry of the amendments requested herein, claims 1 – 64, and 66 will remain pending.
- Of the pending claims, only claims 1, 55, 58 – 60, and 66 are independent.
- Claims 17 and 36 have been amended herein to correct inadvertent errors noted during a review of the application.
- Claim 65 has been cancelled, without prejudice or disclaimer.
- Claim 66 has been clarifyingly amended to make explicit what was inherent in the claim.

**I. Section 102 Rejections**

Claims 1, 3 – 58, and 60 – 66 stand rejected under 35 U.S.C. §102(e) as being unpatentable over U.S. Patent No. 6,285,986 to Andrews (“Andrews” herein). Applicants respectfully traverse this rejection for the reasons set forth below.

In Andrews, participating merchants make available products and services that may be included in bundles. Bundle vendors (vendors that create bundles by selecting some of the products and services made available by the participating merchants) then create bundles from the available products and services and make the bundles available for purchase by potential buyers. The buyers can purchase a created bundle by paying the posted price for the bundle or bidding on the bundle. The products and services included in the bundle purchased by a buyer are then shipped to the buyer.

Applicants’ claimed invention is significantly different. In Applicants’ claimed invention, buyer offer information is received that includes an offer amount associated with a plurality of product categories and a subset of products from each category is selected. For example, an

indication that a buyer desires to purchase pasta sauce (a product category defined as any 16 oz. jar of Barilla™, Seven Brothers™, or Prego™ pasta sauce), toothpaste (a product category defined as any 8 oz. tube of Crest™ or Colgate™ toothpaste), and orange juice (any size container of Tropicana™ orange juice) may be received, along with the price that the buyer is willing to pay for a purchase that includes one product from each of the product categories. One product from each of the product categories may then be selected.

Independent Claims 1, 55, 58, and 60:

Andrews does not teach or suggest all of the features recited in claims **1, 55, 58, and 60**, respectively. In particular, Andrews does not teach or suggest the following features that are each recited in claims **1, 55, 58 and 60**, respectively (emphasis added):

- (i) receiving buyer offer information, including an indication of an offer amount associated with the plurality of product categories; and
- (ii) selecting a subset of the products for each of the product categories

It is not clear to Applicants whether Examiner is interpreting the products and services made available for bundling in Andrews to be product categories or whether Examiner is interpreting the bundles themselves to be product categories. For the rejections of some claims, it appears to Applicants that Examiner is interpreting the products and services made available for bundling as comprising the plurality of product categories while for the rejection of other claims it appears to Applicants that Examiner is interpreting the bundles to be the plurality of product categories. Accordingly, Applicants will address each possible interpretation to illustrate that the above claim limitations are not anticipated by Andrews. However, since only one interpretation is proper, Applicants respectfully request that Examiner clarify which interpretation Examiner is using if Andrews is used as a basis for a rejection in a future Office Action.

Assuming Examiner is interpreting the products and services made available by participating vendors as the plurality of product categories, Applicants respectfully submit that “buyer offer information” (including an offer amount that is associated with the plurality of product categories) is never received for these available products and services. First, a buyer in Andrews purchases a bundle after it is created. The buyer in Andrews never purchases directly any of the products or services as made available by the participating vendors for inclusion in bundles. Examiner cites col. 8, lines 45 – 52 of Andrews as support that the limitation of receiving buyer offer information is anticipated by Andrews. This passage of Andrews, however, simply teaches that when a participating vendor posts a product or service as available for inclusion in a bundle, the participating vendor may indicate whether he is willing to negotiate with a bundle vendor on the price of the product or service when it is included in a bundle (*i.e.*, when the bundle vendor is considering including the product or service in a bundle), as other portions of Andrews make clear (*e.g.*, col. 3, lines 40 – 44; col. 8, lines 41 - 44). The portion of Andrews cited by Examiner has nothing to do with a buyer or any offer being received from a buyer. A bundle vendor is not a buyer and does not buy a bundle but merely creates a bundle that potential buyers may subsequently purchase. As part of the bundle creation process, a bundle vendor may negotiate with the participating vendor that offer a particular product or service about the price or quantity of the product or service so that the bundle vendor may better optimize, *e.g.*, the price of the bundle.

Even if the willingness to negotiate a price with a bundle vendor did teach or suggest the claimed feature of “receiving buyer offer information”, which it does not, this willingness to negotiate a price with a bundle vendor is associated with a particular product. Accordingly, the above claim feature (i) is still not anticipated. What is claimed is “receiving buyer offer information, including an indication of an offer amount associated with the plurality of product categories”. The willingness to negotiate a price with a bundle vendor is provided by a participating vendor in Andrews for a particular product, not for a plurality of different products and certainly not for the plurality of product categories of which an indication was received, as claimed. If Examiner is interpreting the plurality of product categories as being the products and services made available for inclusion in bundles, Applicants note that such products and services are

provided by a variety of different participating vendors in Andrews. Thus, it does not make sense to interpret a single vendor's willingness to negotiate on a price for a particular product as anticipating the claimed feature of an offer amount from a buyer that is associated with the plurality of product categories since, under Examiner's interpretation, the product categories comprise products and services being made available by a plurality of different participating vendors. Accordingly, the above claim feature (i) is not anticipated by this interpretation of Andrews.

Further, still assuming Examiner is interpreting the products and services available for inclusion in a bundle as the plurality of product categories, a subset of the plurality of products for each of the product categories is never selected in Andrews. A bundle vendor in Andrews does select some of the available products and services when creating a bundle. However, there is no teaching or suggestion in Andrews that the bundle vendor creates a bundle by selecting a product or service from each available product category. To the contrary, a bundle vendor in Andrews may create a bundle by selecting products or services all from the same product category or only from some of the product categories. Since great emphasis is placed in Andrews on allowing a bundle vendor to create a bundle that the bundle vendor thinks will be particularly attractive to potential buyers (*see, e.g.*, col. 13, lines 16 – 22), it does not make sense to place the restriction on the bundle vendor of having to select a product or service from each product category when creating a bundle, as is claimed in claims 1, 55, 58, and 60.

Assuming, on the other hand, that Examiner is interpreting the bundles to be the plurality of product categories, it is clear that "a subset of the plurality of products for each of the product categories" is not selected in Andrews under this interpretation either. When a bundle is created, a buyer may purchase the bundle as is or may purchase a plurality of bundles. However, a subset of products from a plurality of bundles (much less from each of the bundles) is never selected in Andrews, for purchase by a buyer or for any other purpose. Allowing a selection of a subset of products from a plurality of bundles, much less from each of the bundles, would defeat the purpose of Andrews (enabling a buyer to purchase a bundle of products created as an attractive package for the buyer). Accordingly, the above feature (ii) is not anticipated under this interpretation of Andrews.

Further, still assuming that Examiner is interpreting the bundles to be the plurality of product categories, when a buyer indicates an interest in purchasing a bundle, any buyer offer information received is not associated with “the plurality of product categories” as claimed in claims 1, 55, 58, and 60 but is rather associated with the particular bundle that the buyer desires to purchase. Accordingly, the above feature (i) is not anticipated by this interpretation either.

Dependent Claims 3 – 54, 56, 57, and 61 – 64

Claims 3 – 54 are each dependent from claim 1. Claims 56 and 57 are each dependent from claim 55. Thus, claims 3 – 54 each include each of the features of claim 1 (and, in particular the three features discussed with respect to claim 1 above). Similarly, claims 56 and 57 each include each of the features of claim 55 (and, in particular, each of the three features discussed with respect to claim 55 above). Accordingly, Applicants respectfully submit that claims 3 – 54 and claims 56 and 57 are each patentable at least for the same reasons as claims 1 and 55, respectively. Claims 61 – 64 are dependent from claim 60. Thus, claims 61 – 64 include each of the features recited in claim 60. Accordingly, Applicants respectfully submit that claims 61 – 64 are patentable at least for the same reasons as claim 60.

For purposes of brevity, the patentability of each of these dependent claims on grounds in addition to those discussed with respect to the respective independent claim from which a given dependent claim depends, is not discussed herein. However, for purposes of illustration, grounds of patentability in addition to those discussed with respect to the independent claims are discussed for some of the dependent claims, below.

Dependent claim 8, for example, recites that “the indication of the plurality of products [of the plurality of product categories] and the buyer offer information are received with respect to a single transaction.” Examiner points generally to col. 8, lines 8 – 64 for support that this feature is anticipated by Andrews. However, upon reviewing the entirety of Andrews, including the portion cited by Examiner, Applicants respectfully disagree that Andrews teaches or even suggests such a feature.

In Andrews, the products and services available for inclusion in a bundle are indicated by participating vendors. At any point after that, bundle vendors may view the

available products and services made available at various times by various participating vendors and select some of the products and services for inclusion in a bundle. There is no teaching or suggestion in Andrews that the indication of available products and services by the participating vendors is done within the same transaction as the creation of a bundle by a bundle vendor. Even if the two processes were performed within the same transaction, which they are not, neither process includes buyer offer information, much less buyer offer information that includes an indication of an offer amount. The bundle creation process is described in Andrews as a process separate from the process of a participating vendor making a product or service available for inclusion in a bundle (the passage cited by Examiner describes the process of a participating vendor making a product or service available for inclusion in a bundle but does not describe the bundle creation process or any purchasing process where buyer offer information may be received). Participating vendors may make products and services available at any time. It does not make sense to interpret Andrews as requiring that all participating vendors make products and services available during the same transaction that a bundle is created by a bundle vendor since Andrews describes the two processes as separate and distinct from one another.

Further, after a bundle is created in Andrews, a buyer may purchase a bundle. However, any buyer offer information received in connection with such a purchase is not received during the same transaction or event as the receipt of an indication from participating merchants of what products or services the participating merchant is making available for inclusion in a bundle. As described, an intervening process of bundle creation occurs between the time that products and services are made available and a time when buyer information associated with a particular bundle is received. Accordingly, the feature of claim 8 is not anticipated by Andrews.

Dependent claims 17 and 18 recite that the products that are selected from each of the plurality of product categories are selected based on at least one of a variety of factors. For example, claim 17 recites a plurality of factors, each of which is a factor associated with the buyer of the products. The portion of Andrews that Examiner cites (col. 5, line 64 – col. 6, line 15; and col. 11, lines 4 – 18), however, merely describes how a purchaser of a bundle may access the system to view and purchase bundles. It appears

that, for purposes of this claim, Examiner is interpreting the bundles as comprising a plurality of product categories. However, when a purchaser in Andrews selects a bundle, the purchaser is selecting the bundle itself. The purchaser is not selecting products from a plurality of bundles and is certainly not selecting at least one product from each of a plurality of product categories or from each of a plurality of bundles, which is what is claimed. Further, there is no selection by any entity in the bundle purchasing process of selecting at least one product from each of a plurality of bundles. There is certainly no selecting of products from a plurality of products based on any of the factors recited in claim 17.

Claim 18 recites that the products selected from each of the plurality of product categories are selected based on the offer amount included in the buyer offer information. In support of the position that this feature is anticipated by Andrews, Examiner cites col. 8 lines 36 – 44. This portion of Andrews, however, merely describes that a portion of the process a participating vendor carries out when the participating vendor is indicated a product or service as available for inclusion in a bundle. There is no selecting of a product in this process, much less of selecting products from each of a plurality of product categories. There is certainly no teaching or suggestion of selecting the products from each of a plurality of product categories based on any factor (in any portion of Andrews), much less based on an offer amount included in buyer information that is received as associated with the plurality of product categories, which is what is claimed.

Dependent claims 19 – 27, and 42 – 46 are each directed to the feature of a subsidy and how a subsidy may be involved in the method of claim 1. A subsidy, as defined by Applicants, is “any benefit that may be applied to a transaction.” Andrews teaches that a participating vendor may provide a coupon, rebate, or other incentive as a product or service available for inclusion in a bundle. Thus, in Andrews a coupon or rebate is a product or service that may be part of a bundle. It is not a benefit applied to a transaction. Further, claims 19 – 27 and 42 – 46 recite that selecting at least one product from each of the plurality of product categories may be based on a subsidy. Andrews does not teach or suggest that a product or service may be selected for any purpose based on a coupon, rebate, or other incentive. Rather, Andrews describes that a coupon or

rebate itself may be selected for inclusion in a bundle (and, again, not that another product or service is selected based on a coupon or rebate).

Dependent claim 36 recites that evaluating buyer offer information comprises “calculating a probability that an offer will be accepted based on (i) the offer amount, and (ii) at least one minimum acceptable price associated with the selected products. Andrews does not describe evaluating buyer offer information in any manner, much less doing so by calculating a probability that an offer will be accepted. The passages of Andrews cited by Examiner in support of the rejection of claim 36 merely describe (i) a process by which a participating member indicates a product or service as available for inclusion in a bundle (col. 8, lines 36 – 59), and (ii) a process for obtaining feedback about a bundle from potential purchasers (col. 11, lines 31 – 51). Neither of these passages (as well as the remainder of Andrews) involves buyer offer information at all (or information about any offer from any entity), much less evaluating buyer offer information. Evaluating buyer offer information by calculating a probability that an offer will be accepted is certainly not described.

Dependent claims 40, 41, 61, and 62 recite “applying a penalty to the buyer based on the evaluation” and what that penalty may comprise, respectively. Andrews does not teach or suggest applying any form of penalty to any entity, much less to a buyer. The passage of Andrews cited by Examiner in support of this rejection merely describes that, if a participating vendor whose product or service is included in a bundle and the bundle vendor that created the bundle do not agree on the bundle profile, changes to the bundle profile may be made. There is no teaching or suggestion of applying a penalty to any entity based on such a disagreement or resultant change.

Dependent claims 47, 48, 63, and 64 each recite one of the following: (i) “determining that the buyer offer information is not acceptable; and providing a suggested modification to the buyer offer information”, and (ii) what the suggested modification may comprise. Andrews does not teach or suggest such features. The passage of Andrews cited by Examiner in support of this rejection merely recites a process in which a participating vendor, when indicating a product or service as available for inclusion in a bundle, may further indicate that the participating vendor is willing to negotiate on the price or quantity of the product or service when the product or service is



included in a bundle. This process does not involve buyer offer information at all or providing any suggested modifications to any offer. This process or any other aspect of Andrews certainly does not teach or suggest providing any suggested modifications if buyer offer information is determined to be not acceptable.

Dependent claim 53 recites “transmitting information enabling a buyer to take possession of the selected products at a merchant.” Andrews explicitly teaches that when a bundle is purchased by a buyer, the products of the bundle are shipped to the buyer (either together or separately). In fact, the passages cited by Examiner in support of this rejection (col. 8, lines 25 – 28; col. 13, lines 43 – 49) explicitly recite that when a bundle is purchased, the products of the bundle are shipped to the buyer. There is no teaching or suggestion in Andrews that a buyer may ever take possession of a product or bundle at a merchant rather than having it shipped.

#### Independent Claim 65

Claim 65 has been cancelled herein, without prejudice or disclaimer. Applicants intend to pursue the subject matter of claim 65 in a continuing application. Accordingly, the rejection of claim 65 is now moot.

#### Independent Claim 66

Examiner did not address claim 66 separately, but rather listed it along with claims 1, 55, 58, 60 and 65 on page 2 of the Office Action. However, this listing of the group of claims is followed by a discussion of claim limitations that are not included in claim 66. Claim 66 is directed to a method performed by a buyer and includes steps not exactly the same as the steps of claims 1, 55, 58, and 60, respectively. Even though the particular steps of claim 66 have not been addressed by Examiner, it is Applicants’ understanding that Examiner takes the position that Andrews anticipates the method of claim 66, a position that Applicants respectfully traverse for the reasons set forth below.

Claim 66 has been clarifyingly amended to recite what was already inherent in the claim: that the selected products comprise at least one product from each of the plurality of product categories. Thus, the claim now recites “providing an indication of a plurality of product categories”, “providing buyer offer information, including an indication of an

offer amount associated with the plurality of product categories” and “receiving an indication of selected products, the selected products comprising at least one product from each of the plurality of product categories”. Andrews does not teach or suggest this claimed process.

First, as discussed above, no entity in Andrews selects at least one product from each of a plurality of product categories. This is true irrespective of which aspect of Andrews is interpreted as comprising the plurality of product categories (*e.g.*, either the products and services available for inclusion in bundles or the bundles themselves).

Second, as also discussed above, no entity in Andrews provides an offer amount associated with the plurality of product categories. Again, this is true irrespective of which aspect of Andrews is interpreted as comprising the plurality of product categories. For example, if the products and services made available by participating merchants is interpreted as the plurality of product categories, a bundle vendor’s ability to negotiate a price for one of those products or services does not teach or suggest an offer amount from a buyer that is associated with the plurality of product categories. This is at least because (i) the bundle vendor is not a buyer, (ii) the bundle vendor does not provide an offer amount for a product or service, and (iii) any negotiation of price is not associated with the plurality of product categories but rather involves a particular product or service. If the bundles themselves are considered the product categories, then a buyer purchasing a bundle also does not anticipate the presently discussed claim limitation because the buyer does not provide an offer amount that is associated with the plurality of product categories that are available for purchase but rather involves the purchase of a particular bundle.

Third, Applicants note that an entity performing the method of claim 66 is an entity that (i) provides an indication of a plurality of product categories, (ii) provides buyer offer information, and (iii) receives an indication of selected products. No entity in Andrews performs each of these steps.

## II. Section 103 Rejections

Claims 2 and 59 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Andrews in view of PCT Publication WO/9834187 to Grofthehaug et al. ("Grofthehaug" herein). Applicants respectfully traverse this rejection for the reasons set forth below.

### Dependent Claim 2

Claim 2 recites that the indication of the plurality of product categories is received from a buyer. While Examiner acknowledges that Andrews does not teach receiving the indication of the plurality of categories from a buyer, Examiner asserts that Grofthehaug does teach receiving such an indication from a buyer. (pg. 8 of paper no. 8) and therefore claim 2 is obvious over Andrews in view of Grofthehaug. Applicants respectfully traverse this rejection on various grounds.

First, Grofthehaug does not teach receiving an indication of *a plurality of product categories* from a buyer. Rather, a bidder in Grofthehaug may indicate a plurality of *products* (as opposed to product categories) that the bidder desires to bid on.

Second, even if Grofthehaug did teach receiving an indication of a plurality of product categories (which it does not), combining it with Andrews would still not result in Applicants' claimed invention. Returning to the two possible interpretations of Andrews discussed above:

(i) If the products and services indicated by participating merchants as available for inclusion in bundles are interpreted as the plurality of product categories, it is not possible for a buyer in Andrews to provide an indication of these. First, a buyer has no access to what products or services a participating merchant desires to make available for inclusion in bundles. Only the participating merchant can decide that and provide an appropriate indication. Second, a buyer in Andrews can only view and purchase the bundles after they are created. There is no disclosure in Andrews that a buyer may view or otherwise access the products or services made available by participating merchants before the products and services are included in bundles.

(ii) If the bundles themselves are interpreted as the plurality of product categories, the remaining steps of the claim 2 are still not taught or suggested by the combination of

Andrews and Grofthehaug. Assuming that the indication of a plurality of bundles are received from a buyer in Andrews, another step in the method of claim 2 (by virtue of it being dependent from claim 1) comprises selecting a subset of the plurality of products for each of the product categories. In the present interpretation of Andrews, this would comprise selecting a subset of products from each of the bundles indicated by the buyer. Such a step is not taught or suggested by Andrews.

Third, no proper motivation to combine Andrews and Grofthehaug has been provided by Examiner, as is discussed in detail below.

#### Independent Claim 59

Andrews does not teach or suggest all of the features recited in claim 59. In particular, Andrews does not teach or suggest the following features that are each recited in claim 59 (emphasis added):

- (i) selecting a first product from the first set of products and selecting a second product from the second set of products, wherein at least one of the first product and the second product are selected based on an associated subsidy;
- (ii) transmitting information enabling the buyer to take possession of the first product and the second product at a merchant.

Examiner asserts that Andrews teaches both of the above features. Applicants respectfully disagree. Regarding feature (i), Andrews does not disclose selecting any product based on a subsidy. As discussed above, in Andrews a coupon, rebate, or other incentive may be selected as a product within a bundle. However, a product is not selected for inclusion in a bundle based on a coupon, rebate, other incentive, or a subsidy. Regarding feature (ii), as also discussed above, Andrews does not disclose that a buyer may take possession of a bundle or product of a bundle at a merchant. All products in Andrews as shipped to the buyer.

Examiner relies on Grofthehauge as teaching the step of receiving from a buyer a binding buyer offer. As described above, Applicants disagree that this feature is taught by Grofthehauge and, even if it were, the resultant combination does not result in the claimed invention for the same reasons as described with respect to claim 2.

Lack of Proper Motivation to Combine

Applicants respectfully submit that a sufficient or proper motivation to combine Andrews with Grofthehauge has not been provided. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found in the record. MPEP 706.02(j). *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 21 USPQ2d 1941 (Fed. Cir. 1992). It is the burden of the Examiner to establish a *prima facie* case of obviousness by pointing to a *specific* teaching in the record that would have motivated one of ordinary skill in the art to modify or combine the prior art in the manner suggested by Examiner. *In re Fine*, at 1598 (*emphasis added*). Applicants respectfully submit that Examiner has not met this *prima facie* burden for the pending claims because Examiner has not pointed to a specific teaching or suggestion *in the prior art* but has merely provided an unsupported conclusory statement. Examiner's statement that it would have been obvious to combine the prior art "so as to provide a prioritized list of choices which a buyer may possibly desire to buy" is not sufficient to meet the Examiner's burden of providing a *prima facie* case of obviousness. A specific teaching in the references themselves, one that would have motivated a person of ordinary skill in the art to combine Andrews and Grofthehauge in the manner suggested by Examiner, has not been cited by Examiner.

If Examiner maintains the position that each of the limitations of the pending claims are taught by the prior art, which Applicants submit they are not, Applicants urge Examiner to apply a proper obviousness analysis and point to a specific suggestion in the prior art or within the knowledge of one of ordinary skill in the art that would make the suggested combination/modification of the prior art result in Applicants' claimed invention. A proper obviousness analysis cannot be "limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention"

(*In Re Dembiczak*, 175 F.3d 994, Fed. Cir. 1999, holding that the Board of Appeals holding of obviousness cannot stand as a matter of law, due to the Board's failure to support its finding of obviousness by a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims). "Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight." (*Id.*).

**VI. Conclusion and Petition for Extension of Time**

For the foregoing reasons it is submitted that all of the claims are now in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Magdalena M. Fincham at telephone number 203-461-7041 or via electronic mail at mfincham@walkerdigital.com.

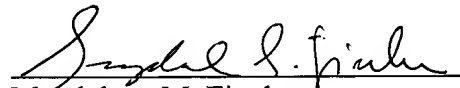
**Petition for Extension of Time to Respond**

Applicants believe a one-month extension of time within which to respond to the Office Action is due with this response. Accordingly, Applicants petition for a one-month extension of time and authorize the charge of \$55.00 to our Deposit Account No. 50 - 0271. However, if an additional fee should be due, please charge it to our Deposit Account No. 50-0271. Please charge any additional fees that may be required for this Response, or credit any overpayment to Deposit Account No. 50-0271.

If an extension of time is required, or if an additional extension of time is required in addition to that requested in a petition for an extension of time, please grant a petition for that extension of time which is required to make this Response timely, and please charge any fee for such extension to Deposit Account No. 50-0271.

Respectfully submitted,

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Date

  
Magdalena M. Fincham  
Attorney for Applicants  
Registration No. 46,085  
mfincham@walkerdigital.com  
203-461-7041 / voice  
203-461-7300 / fax